

REMARKS

In the Office Action, the Examiner rejected claims 10-12 and 26-33 under 35 U.S.C. § 103. Claims 10-12 and 26-33 remain pending. In view of the following remarks, Applicants respectfully submit that the pending claims are in condition for allowance.

Claim Objections

The Examiner objected to the terms “connector member” and “disengaging member” in claim 10 for having no proper antecedent basis in the specification. The Applicants believe this objection to be unwarranted and respectfully disagree with the Examiner.

In particular, the Applicants note that, by statute, a claim is merely required to “point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112. The Code of Federal Regulations has expounded on these requirements in stating that “[t]he claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 C.F.R. § 1.75(d)(1). The Applicants do not believe the plain language of the statute or regulations requires absolute identity between a term recited in a claim and the terminology employed in the detailed description. Instead, the regulations appear to clearly

contemplate the use of different terminology in the claims and detailed description so long as the claim term is clearly supported so that its meaning is ascertainable by reference to the description. The Applicants believe that the terms "connector member" and "disengaging member" have such support in the detailed description of the present application. *See Application*, page 8, lines 15 to page 9, line 3; page 12, lines 12-21; page 13, line 12 to page 14, line 15. Therefore, absent some showing by the Examiner of a statutory, regulatory, or case law basis requiring absolute identity between claim and description terminology, the Applicants respectfully choose to maintain the existing terminology of claim 10.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 10-12 and 26-33 under 35 U.S.C. § 103(a) as obvious in view of U.S. Patent No. 6,061,239 (the Blomquist reference) and U.S. Patent No. 6,108,207 (the Lee reference). The Applicants respectfully traverse this rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a

convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

In view of this binding precedent, the Applicants believe that the Examiner's rejection of claims 10-12 and 26-33 as obvious in view of the cited art is deficient for at least two reasons. First, the proposed modification impermissibly changes the principle of operation of the heat sink clip of the primary reference. Second, the Examiner has improperly relied upon the level of skill in the art as the motivation to make the suggested combination without providing some objective reason to combine the teachings of the references.

1. *The proposed modification changes the principle of operation of the clip of the Blomquist reference*

With regard to the first deficiency, no *prima facie* case of obviousness can exist where the cited combination of references would change the principle of operation of the prior art invention being modified, here the heat sink clip of the Blomquist reference.

See In re Ratti, 270 F.2d 810, 813; 123, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) and

M.P.E.P. § 2143.01. As in the facts of *In re Ratti*, the suggested combination would involve the reconstruction and redesign of the elements of the cited clip and would change the principle of operation of the cited clip. In particular, the Blomquist reference discloses a principle of operation in which a cam-type latch 60 of the retainer clip 30 may be rotated such that in one position it causes the cam to apply pressure to a heat sink. *See* Blomquist, col. 3, lines 28-32 and col. 5, lines 23-46. Use of the cam-type latch 60 as part of a removal mechanism, as proposed by the Examiner, is not discussed or disclosed by the Blomquist reference and cannot be considered part of the principle of operation of the clip. Indeed, figures 8 and 9 of the Blomquist reference clearly demonstrate that the effect of rotating the cam-type latch 60 is to apply or release pressure on the heat sink base 24, not to disengage the hook portions 44, 45 from the wall 12. Therefore, the position of the Examiner, which relies upon the cam-type latch 60 as part of a mechanism for disengaging the clip from a heat sink, constitutes an impermissible change in the principle of operation of the clip of the Blomquist reference.

Furthermore, the cam-type latch 60 of the Blomquist reference appears to be unsuitable for the purpose proposed by the Examiner, i.e., for use as a pinchable disengagement mechanism. Figures 4, 5 and 8 of the Blomquist reference clearly depict a cam-type latch which is angled in the direction of the proposed pinching force and which contains two extensions 67, 68 which extend in an opposing direction to the proposed pinching force. In effect, the Examiner is arguing that an angled cam arm with extensions which would cut into the flesh of a user is suitable to be pinched with

sufficient force to distort the clip body sufficiently to disengage the clip. Instead, to permit the use proposed by the Examiner, the cam-type latch 60 would have to be redesigned, as in the fact pattern of *In re Ratti*, to configure the cam-type latch for use as a pinchable disengagement mechanism. Therefore, in view of the change in the principle of operation and the associated redesign to the clip that the change in principle of operation would necessitate, the Applicants respectfully assert that the cited combination is unavailable to the Examiner to make out a *prima facie* case of obviousness.

2. *A motivation to combine references based solely on an assertion that such a combination is within the capabilities of one of ordinary skill in the art is not sufficient to establish a prima facie case of obviousness*

In addition, the Applicants respectfully note that, even if the proposed modification did not impermissibly alter the principle of operation of the Blomquist clip, the suggested combination of the Blomquist and Lee references would still be unavailable to the Examiner. In particular, the Examiner has relied solely on the level of skill in the art to provide the necessary motivation to combine the Blomquist and Lee references, stating that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the retainer clip in Blomquist with an additional removal arm and to be extending outwardly from its clip in such a way that when a pinching force applied thereon and its rotatable arm rotated to the unlocked position its connector members (50,51) will be disengaged from its main body for disengaging its heat sink in the manner taught, disclosed and suggested by Lee, especially, since such modification involves only routine skill in the art.

Office Action mailed on May 26, 2004, page 4.

Such reliance is misplaced. It is well settled that, even in the case of a technologically simple innovation, a motivation to combine references requires that there must be some finding as to a specific understanding or principle within the knowledge of one of ordinary skill in the art that would motivate one, without the hindsight provided by the application, to make the combination in the manner suggested. *See In re Kotzab*, 217 F.3d 1365, 1371; 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) and M.P.E.P. § 2143.01.

In accordance with this body of law, the M.P.E.P. instructs that, in establishing a *prima facie* case of obviousness, it is insufficient to merely state that a combination would have been well within the ordinary skill in the art. *See* M.P.E.P. § 2143.01. Instead, some *objective* reason to combine the references must be provided. *Id.* The Examiner has failed to provide such an objective reason. Furthermore, in view of the preceding discussion as to the principle of operation of the Blomquist clip and dissimilar operation of the clip of the Lee reference, the Applicants do not believe such as objective reason will be identified.

Conclusion

In view of the remarks set forth above, the Applicants believe that the Examiner has failed to establish a *prima facie* case of obviousness. Furthermore, in view of the preceding comments, the Applicants do not believe such a *prima facie* case can be

established based on the cited references. Therefore, the Applicants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Applicant kindly invites the Examiner to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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